



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/980,973 | 02/21/2002 | Hannu Honkala | 4925-164PUS | 3616 |

7590

07/05/2005

Michael C Stuart
Cohen Pontani Lieberman & Pavane
551 Fifth Avenue Suite 1210
New York, NY 10176

EXAMINER

CUMMING, WILLIAM D

ART UNIT

PAPER NUMBER

2683

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,973

Applicant(s)

HONKALA, ET AL

Examiner

WILLIAM D CUMMING

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed means of the internal network controller as stated by claim 7; the internal cellular network controller comprising a base transceiver station as stated by claim 8; the step of setting up communication channel as stated by claim 1 must be shown or the features canceled from the claims. No new matter should be entered.

2. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" (37 CFR 1.121(d)) and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

Timing of Corrections

Applicants are required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The specification inadequately describe and/or fail to originally support each of the claimed means of the internal network controller as stated by claim 7, the internal cellular network controller comprising a base transceiver station as stated by claim 8 and the now claimed step of setting a communication channel in the external network. The "*written description*" of the invention required by first paragraph of 35 USC §112 is separate and distinct from that paragraph's requirement of enabling disclosure, since description must do more than merely provide explanation of how to "*make and use*" the invention. Applicants must also convey, with reasonable clarity to those skilled in the art, that applicants, as of the filing date sought, was in possession of the invention, with the invention being, for purpose of "*written description*" inquiry, whatever is presently claimed. Drawings alone may, under proper circumstances, provide "*written description*" of the invention required by 35 USC §112, and whether the drawings are from design application or utility application is not determinative. In order to satisfy "*written description*" requirement of 35 USC §112, the proper test is whether drawings conveys, with reasonable clarity to those of ordinary skill in the art, the claim subject matter.

6. Claims 7-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to provide an enabling disclosure for the claimed means for detecting the movement of the mobile station in the internal network controller; the means for selectively issuing a hand-off advance request; the means for setting up a communication channel. The specification also fails to show how each of said means are connected to each other in the internal cellular network. Also the internal cellular network controller comprising a base transceiver station as stated by claim 8, the specification does not show a base station transceiver station in the internal cellular network controller and how it would be done. These internal components of the internal cellular network controller are known only to the inventors.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kim, et al** in view of **Willars** and **Barnes, et al**

Regarding claim 1, **Kim** discloses a method of handing off a mobile station (figure 1, #10) from an internal cellular communications network to an external cellular communications network having a network controller, the method comprising detecting the movement of said mobile station into said border cell (see col. 3, lines 8 - 22). Generating an advance hand-off request in accordance

with a prediction algorithm which uses a set of predetermined parameters associates with said mobile station (#10) and determines when a hand off is likely to be required (see col. 3, lines 13—31) and response to said advance hand-off request setting up a communications channel in the external cellular communications network for use by said mobile station when an actual hand-off request is made (see col. 2, lines 31 —37), wherein said external network is a mobile communications network and said internal network is a packet switched network and said internal cellular network transmits and receives a plurality of signals using the same communication standard for radio frequency communication as said external cellular network (see col. 5, lines 42 — 53). However, Kim fails to disclose allocating at least one cell of the internal cellular network as a border cell. detecting the movement of said mobile station into said border cell. **Willars** teaches allocating at least one cell of the internal cellular network as a border cell and detecting the movement of said mobile station (#figure 1, #30) into border cell (see col.4, line 57 to col. 5, line 15). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of claimed invention was made to provide the above teaching of **Willars** to **Kim's** method, in order to improve voice and data communication in the cellular telecommunication network.

The examiner takes Official Notice border cells between two cellular communication networks being adjacent to each other is old and well know in the art, in fact, it is required for any handoff between one cellular communication network and to another cellular communication network. The examiner also takes Official Notice that setting up a communication channel in the external network in a response of any type hand-off request for use of the mobile station when an actual handoff is made is old and well known in the art, if not, no handoff is then possible. The examiner cites **Barnes, et al** as evidence that border cells between two cellular communication networks being adjacent to each other and setting up a communication channel in the external network in a response of any type hand-off request for use of the mobile station when an actual handoff is made is at least twenty-year old and familiar to all skilled in the art. It also evidence that applicants did not invent setting up a communication channel in the external network in a response of any type hand-off request for use of the mobile station when an actual handoff is made. Applicants are intentionally copying the aged and well known setting up a communication channel in the external network in a response of any type hand-off request for use of the mobile station when an actual handoff is made into their so called invention.

Regarding claim 2, the combination of **Kim** and **Willars** disclose said network controller implements hand-off to said communication response to an actual hand-off request (see **Kim**, col. 3, lines 8 —26).

Regarding claims 3 and 10, the combination of **Kim** and **Willars** disclose said mobile station is in communication with a base transceiver station in the internal cellular communications network prior to handoff (see **Kim**, col. 1, lines 25—41).

Regarding claim 4, the combination of **Kim** and **Willars** disclose said predetermined parameters for use by said prediction algorithm includes timing advance information required from the base station to the mobile station (see **Kim**, col. 5, lines 5- 9).

Regarding claims 5,11,12 and 13, the combination of **Kim** and **Willars** disclose the internal cellular communications network comprises an internal network controller, which carries out the prediction and issues said hand-off advance request (see **Kim**, col. 3, lines 8 —22).

Regarding claim 6, the combination of **Kim** and **Willars** disclose said hand-off advance request is issued in packet format via a packet communication path from the internal network controller to said network controller of said external network (see **Kim**, Col. 3, lines 8—22).

Regarding claims 7 and 15, the combination of **Kim** and **Willars** disclose a network controller for use in an internal cellular communications network or cellular communication network, said internal network is a packet switched network (see **Kim**, col. 2, lines 18— 23) and comprises a plurality of cells and including at least one border cell, said at least one border cell being adjacent cells of an external mobile cellular communications network having an external

network controller (see **Willars**, col. 4, line 57 to col.5, line 5). The internal network controller comprising means for detecting the movement of said mobile station (#10) into said border cell (see **Kim**, col. 3, lines 8 —22). Means for selectively issuing a hand-off advance request advising said network controller of said external network that a hand-off is likely to be- required (see **Kim**, col. 3, lines 13— 31) in accordance with a predetermined algorithm which uses a set of predetermined parameters associated with said mobile station (see **Kim**, col. 5, lines 5 — 9) and means for setting up a communication channel in the external communication network for use by said mobile station (#10) when an actual hand-off request is made (see **Kim**, col. 2, lines 31 —37). Said internal cellular network transmits and receives a plurality of signals using the same communication standard for radio frequency-communication as said external cellular network (see **Kim**, col. 5, lines 42 —53).

Regarding claim 8, the combination of **Kim** and **Willars** disclose a base transceiver station operate to set up an RF communication channel with said mobile station (see **Kim**, col. lines 25—41).

Regarding claims 9 and 14, the combination of **Kim** and **Willars** disclose said external network controller is in communication with said internal network controller by a packet communication path for transmission of said hand-off advance request (see **Kim**, col. 3, lines 8— 22).

Response to Amendment**11. Updated Notice of Centralized Delivery and Facsimile Transmission Policy for Patent Related Correspondence, and Exceptions Thereto**

On December 1, 2003, the United States Patent and Trademark Office (Office) established a "*centralized delivery*" policy for patent related correspondence to enable the Office to promptly scan the correspondence into the Office's image file wrapper (IFW) system. The "*centralized delivery*" policy requires most patent related correspondence to be: a) faxed to the central facsimile number ((703) 872-9306), b) hand carried or delivered to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), or c) mailed to the mailing address set forth in 37 CFR 1.1 (e.g., P.O. Box 1450, Alexandria, VA 22313-1450).i The "*centralized delivery*" policy was revised in three follow-up notices. In order to provide further updated information, and to provide a single comprehensive statement of the Office's current "*centralized delivery*" policy, this notice is issued. This notice replaces all prior Office notices specifying a specific fax number or hand carry address for certain patent related correspondence.

General "*Centralized Delivery*" Policy:

For patent related correspondence, hand carry deliveries must be made to the Customer Service Window, and facsimile transmissions must be sent to the central facsimile number ((703) 872-9306), unless an exception, as noted below, applies. Exceptions to the general policy of "*centralized delivery*" generally involve situations where special handling of the patent related correspondence is

available. All the current exceptions are listed in this notice. Correspondence which is not related to a specific patent or patent application, such as a question on policy, on employment, or other general inquiry, is not covered by this notice. Below are two lists which set forth all the current exceptions to the "*centralized delivery*" policy. The first list covers the exceptions for certain hand carried items, and the second list covers the exceptions for certain facsimile transmitted items. Both lists reflect the relocation of most USPTO operations to the Alexandria, Virginia campus.

List I – Exceptions for Certain Hand Carried Correspondence Current exceptions:

Only the following types of correspondence may be delivered (hand-carried) to the specific location provided below instead of the Customer Service Window. If correspondence listed below is carried to the Customer Service Window, the correspondence will be accepted and routed to the appropriate office.

1. Access Requests:

Requests for access to patent application files may continue to be hand carried to the File Information Unit (FIU) in Room 2E04, 2900 Crystal Drive (South Tower), Arlington VA 22202. Requests for access to patent application files that are maintained in the Image File Wrapper system and that have not yet been published may also be hand carried to the Public Search Facility on the 1st floor of the Madison East building, 600 Dulany Street, Alexandria VA 22314.

2. Patent Term Extensions under 35 U.S.C. § 156:

Patent term extension applications under 35 U.S.C. 156 (Hatch/Waxman) may be hand-carried to the Office of Patent Legal Administration (OPLA) in Room 07D85, 600 Dulany Street (Madison West building), Alexandria VA 22314. At the guard station in Madison West (near the elevators), the security guard should call the OPLA at either (571) 272-7744 or (571) 272-7746 for delivery assistance.

3. Assignments to be Recorded:

Assignments may be hand-carried to the Office of Public Records Customer Service Window on the 2nd floor of the South Tower building, 2900 Crystal Drive, Arlington VA 22202.

4. Office of General Counsel:

Correspondence for the Office of General Counsel may be hand-carried to the Office of General Counsel in Room 10C20, 600 Dulany Street (Madison East building), Alexandria VA 22314. At the guard station in Madison East (near the elevators), the security guard should call the Office of General Counsel at 571-272-7000 for delivery assistance.

5. Solicitor's Office:

Correspondence for the Solicitor's Office may be hand-carried to the Solicitor's Office in Room 8C43, 600 Dulany Street

(Madison West building), Alexandria VA 22314. At the guard station in Madison West (near the elevators), the security guard should call the Solicitor's Office at 571-272-9035 for delivery assistance.

6. Interference related correspondence:

Correspondence relating to interferences may be hand-carried to the 1st floor lobby of Madison East building, 600 Dulany Street, Alexandria VA 22314, where a drop-off box for hand-carried documents to be filed with the Board of Patent Appeals and Interferences is located. Customers need to pass through the magnetometer and have the materials passed through the x-ray sensors before placing them in the drop-off box. The drop-off box is for Interference related correspondence **ONLY**. Boxes are not permitted in the drop-off box. Boxed materials should be hand-carried to Madison East, Room 9B55-A using the following procedures. At either guard station (concourse level or 1st floor) in Madison East (near the elevators), the security guard should call the Board of Patent Appeals and Interferences at 571-272-9797 to obtain authorization to allow entry into the building for delivery to Room 9B55-A. Access to Room 9B55-A is available from 8:30 AM to 4:45 PM only. Documents/boxes hand-carried to the drop-off box or to Room 9B55-A after 4:45 PM (EST) will receive the next day's filing date. Customers desiring a stamped return receipt for their

filing need to personally bring their filing and postcard to Room 9B55-A during the hours stated above, or leave the postcard with the filing (postcard must include correct postage mail stamp and the address where the postcard it to be mailed). The Board will stamp the filing date and mail the postcard to the customer.

7. Secrecy Order:

Applications subject to a secrecy order pursuant to 35 U.S.C. 181, or are national security classified, and correspondence related thereto, may be hand-carried to the Licensing and Review location. See 37 CFR Secs. 5.1(c) and 5.2(c). Licensing and review is expected to relocate to the Alexandria campus on April 1, 2005. Effective April 1, 2005, the Licensing and Review location is:

Technology Center 3600, Room 4B31, 501 Dulany Street (Knox building), Alexandria VA 22314.

At the guard station in Knox (near the elevators), the security guard should call Licensing and Review at (571) 272-8203 for delivery assistance. Prior to April 1, 2005, the Licensing and Review location is:

Technology Center 3600, Office of the Director, 2451 Crystal Drive (Crystal Park 5 building), Room 3D07
Arlington, VA 22202.

8. Explicit Foreign Filing License Petitions:

Effective April 1, 2005, petitions for foreign filing license pursuant to 37 CFR 5.12(b) for which expedited handling is requested and petitions for retroactive license under 37 CFR 5.25, may be hand-carried to Licensing and Review in Room 4B41, 501 Dulany Street (Knox building), Alexandria VA 22314. At the guard station in Knox (near the elevators), the security guard should call Licensing and Review at (571) 272-8187 for delivery assistance.

9. Petitions to Withdraw from Issue:

Petitions to Withdraw from Issue may be hand carried to the Office of Petitions on the 7th floor of the Madison West building, 600 Dulany Street, Alexandria VA 22314. At the guard station in Madison West (near the elevators), the security guard should call the Office of Petitions at (571) 272-3282 for delivery assistance. Hand carried papers will be accepted between the hours of 8:30 a.m. until 3:45 p.m.

10. Documents requested by the Office of Patent

Publication:

Documents requested by the Office of Patent Publication may be hand carried to the Office of Patent Publication in Room 8A24, 2900 Crystal Drive (South Tower building), Arlington VA 22202, during business hours.

Elimination of certain previously authorized exceptions:

Hand carry delivery to a location other than the Customer Service Window is no longer permitted for the following types of correspondence:

(1) correspondence relating to PCT international applications prior to national stage entry (35 U.S.C. 371) [Note: as of January 14, 2005, there no longer is a separate PCT Operations Customer Window];

(2) petitions for express abandonment to avoid publication under 37 CFR 1.138(c);

(3) requests to initiate, or related to on-going, ex parte or inter partes reexamination proceedings;

(4) design patent applications with a corresponding request for expedited examination under 37 CFR 1.155; and (5) correspondence for the Office of Enrollment and Discipline (OED).

List II -Exceptions for Certain Facsimile Transmitted Correspondence For each Office location listed below, only the particular type of correspondence indicated may be transmitted to the specific facsimile number at that Office location. All other types of facsimile transmitted correspondence must be sent to the central facsimile number ((703) 872-9306).

1. Office of Initial Patent Examination (OIPE) Request for corrected Filing

Receipt:

(703) 746-9195 facsimile number

Response to Notice to File Missing Parts:

(703) 746-4060 facsimile number

Note: New applications, correspondence being submitted for the purpose of obtaining an application filing date, and color drawings may NOT be transmitted by facsimile. OIPE Customer Service telephone number: (703) 308-1202

2. PCT Operations and PCT Legal Administration Correspondence

subsequent to filing in an international application before the U.S. Receiving Office, the U.S. International Searching Authority, or the U.S. International Examining Authority:

Papers in international applications:

(703) 305-3230 facsimile number

Response to Decisions on Petition:

(571) 273-0459 facsimile number

Note: An international application for patent or a copy of the international application and the basic national fee necessary to enter the national stage, as specified in 37 CFR 1.495(b), may NOT be submitted by facsimile. See 37 CFR 1.6(d)(3) (referencing 37 CFR 1.8(a)(2)(i)(D) and (F)). Subsequent

correspondence may be transmitted by facsimile in an application before the U.S. Receiving Office, the U.S. International Searching Authority, or the U.S. International Examining Authority, but it will **NOT** receive the benefit of any certificate of transmission (or mailing). See 37 CFR 1.8(a)(2) (i)(E).

Correspondence during national stage, subsequent to entry, are handled in the same manner as a U.S. national application.

The PCT Help Desk:

(571) 273-0419 facsimile number (703) 305-3257 telephone number

3. Office of Patent Publication Payment of an issue fee and any required publication fee by authorization to charge a deposit account or credit card, and drawings:

(703) 746-4000 facsimile number

Note: Although submission of drawings by facsimile may reduce the quality of the drawings, the Office will generally print the drawings as received. Office of Patent Publication telephone numbers to check on receipt of payment: (703) 308-6789 or 1-888-786-0101

4. Office of Pre-Grant Publication Petitions for express abandonment to avoid publication under 37 CFR 1.138(c), and Requests for express abandonment under 37 CFR 1.138: (703) 305-8568 facsimile number

Pre-Grant Publication Division telephone number for questions relating to the publication of patent applications:

(703) 605-4283. Questions may also be directed by e-mail to
pgpub@uspto.gov.

5. Electronic Business Center (EBC) Requests for Customer Number Data
Change (PTO/SB/124), and Requests for a Customer Number (PTO/SB/125):

(703) 308-2840 facsimile number.

Note: The EBC may also be reached by e-mail at: ebc@uspto.gov.

EBC telephone number for customer service and assistance:

(866) 217-9197

6. Assignment Branch Assignments or other documents affecting title:

(703) 306-5995 facsimile number

Note: Customers may submit documents directly into the automated
Patent and Trademark Assignment System and receive the resulting recordation
notice at their facsimile machine. (Assignment documents submitted through the
Electronic Patent Assignment System also permits the recordation notice to be
faxed to customers.) Credit card payments to record assignment documents are
now accepted, and use of the Credit Card form (PTO-2038) is required for the
credit card information to be separated from the assignment records. Only
documents with an identified patent application or patent number, a single cover
sheet to record a single type of transaction, and the fee paid by an authorization
to charge a USPTO deposit account or credit card may be submitted via
facsimile. Please refer to the USPTO Web Site, at

<http://www.uspto.gov/web/offices/ac/ido/opr/ptasfax.pdf> for more information regarding the submission of assignment documents via facsimile.

Assignment Branch telephone number for assistance:

(703) 308-9723 7.

Central Reexamination Unit (CRU) *Inter partes* reexamination correspondence, except for the initial request: (571) 273-0100 facsimile number

Note: All *ex parte* reexamination correspondence, except for the initial request, may be sent by facsimile transmission to the central facsimile number. Correspondence related to reexamination proceedings will be separately scanned in the CRU.

CRU telephone number for customer service and inquiries: (571) 272-7705 8.

Board of Patent Appeals and Interferences Correspondence related to pending interferences permitted to be transmitted by facsimile (only where expressly authorized, see 37 CFR 1.6(d)(9)):

(571) 273-0042 facsimile number

Note: Correspondence should not be transmitted to this number if an interference has not yet been declared.

9. Office of the General Counsel Correspondence permitted to be transmitted to the Office of General Counsel:

(571) 273-0099 facsimile number

10. Office of the Solicitor Correspondence permitted to be transmitted by facsimile to the Office of the Solicitor:

(571) 273-0373 facsimile number

11. Licensing and Review Petitions for a foreign filing license pursuant to 37 CFR 5.12(b), including a petition for a foreign filing license where there is no corresponding U.S. application (37 CFR 5.13):

(571) 273-0185 facsimile number (if the fax is transmitted on or after April 1, 2005) (703) 305-7658 facsimile number (if the fax is transmitted prior to April 1, 2005)

Note: Correspondence to be filed in a patent application subject to a secrecy order under 37 CFR Sec. 5.1 through 5.5 and directly related to the secrecy order content of the application may **NOT** be transmitted via facsimile.
See 37 CFR Sec. 1.6(d)(6).

12. Office of Petitions Petitions to Withdraw from Issue:

(571) 273-0025 facsimile number

Note: All other types of petitions must be directed to the Central Facsimile Number ((703) 872-9306). Any paper other than a Petition to Withdraw from Issue which is sent to the Office of Petitions fax number (instead of the Central Facsimile Number) will be discarded. Petitions sent to the Central Facsimile Number should be marked "Special Processing Submission".

Questions regarding this notice may be e-mailed to **PatentPractice@uspto.gov**, or directed to the Inventors' Assistance Center by telephone at (800)786-9199, or (703)308-4357. 3/2/05

12. Termination of the Waiver of Provisions of 37 CFR 1.8 and 1.10 for Correspondence Intended for the United States Patent and Trademark Office but Addressed to Washington, DC 20231

Effective on April 4, 2005, the provisions of 37 CFR 1.8 (Certificate of Mailing) and 1.10 ("Express Mail") will no longer be waived for correspondence addressed to the United States Patent and Trademark Office (USPTO), Washington, DC 20231. On May 1, 2003, the USPTO changed its address for certain correspondence to P.O. Box 1450, Alexandria, VA 22313-1450. See 37 CFR 1.1 and *Correspondence with the United States Patent and Trademark Office*, 68 Fed. Reg. 14332 (March 25, 2003), 1269 *Off. Gaz. Pat. Office* 159 (Apr. 22, 2003). To allow applicants time to become accustomed to the new address in Alexandria, VA, the USPTO waived the provisions of 37 CFR 1.8 and 1.10 such that correspondence addressed to Washington, DC 20231 would be treated as acceptable under 37 CFR 1.8 and 1.10 for otherwise compliant Certificates of Mailing and "Express Mail." The United States Postal Service (USPS) has ceased forwarding to the USPTO correspondence addressed to Washington, DC 20231. Additionally, the USPTO will no longer arrange for the delivery to Alexandria, VA of correspondence addressed to Washington, DC 20231 after April 3, 2005. Thus, after April 3, 2005, all correspondence addressed to the Washington, DC 20231 address will

be returned to sender marked by the USPS as undeliverable. Such mail returned to the sender by the USPS **will not** be considered proof of prior filing or mailing under 37 CFR 1.8(b) or 1.10(e) since the correspondence was not mailed in accordance with 37 CFR 1.1. Pursuant to 37 CFR 1.1, correspondence intended for the USPTO must be mailed to P.O. Box 1450, Alexandria, VA 22313-1450, except as otherwise provided.

1. Correspondence intended for the USPTO, unless directed otherwise, must be addressed to: Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

2. Correspondence in patent-related matters to organizations reporting to the Commissioner for Patents must be addressed to: Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

3. Correspondence in trademark-related matters, except documents sent to the Assignment Services Division for recordation, requests for copies of trademark documents, and documents directed to the Madrid Processing Unit, must be addressed to: Commissioner for Trademarks P.O. Box 1451 Alexandria, VA 22313-1451

The above addresses are the USPTO's three general mailing addresses for mail delivered by the USPS; however, the USPTO has separate mailing addresses for certain correspondence as set forth in the notice titled "*Mailing and Hand Carry Addresses for Mail to the United States Patent and Trademark Office*" (formerly, "*Special Mail Stops For Patent Mail*") that is published each week in the Official Gazette Notices and posted on the USPTO Internet web site. Questions regarding this notice

may be e-mailed to PatentPractice@uspto.gov, or directed to the Inventors' Assistance Center (formerly the Patent Assistance Center (PAC)) by telephone at 800-786-9199 or 703-308-4357. Date: 3/1/05

Conclusion

13. Applicants' arguments filed March 9, 2005 have been fully considered but they are not persuasive.

Enablement requirement of 35 USC 112 is satisfied if the specification contains description that enables one skilled in the art to make and use the claimed invention (Fiers v. Sugano, 25 USPQ2d 1601). The examiner, in holding that disclosure is not enabling, can rely upon sound scientific reasoning as acceptable alternative to patents and printed publications. Lack of working examples is not controlling in determining whether disclosure meets enablement requirement of 35 USC §112. A patent applicant who chooses to forego exemplification and bases utility on broad terminology and general allegations runs risk that, unless one with ordinary skill in art would accept allegations as obviously valid and correct, examiner may properly ask for evidence to substantiate them (Ex parte Sudilovsky, 21 USPQ2d 1702). Applicants' attorney supplied no evidence, but empty arguments. Attorney's arguments are no substitution of evidence. Actually, applicants' attorney remarks supports examiner conclusion of non-enablement by stating that some of the means and function of these means are not done by the network controller (#3), but with other items in the cellular communication network (BTS, #4). This is why claim

15 is enabling and claim 7 is not. Because of applicants' attorney's remarks and the evidence in front of the examiner, the examiner cannot withdraw the objection to the drawings and the 35 USC § 112 rejections.

Regarding claim 8, all the drawings and the specification show the BTS outside the network controller #3, hence the network controller does not comprise of a BTS. If there is one, applicants' attorney unsuccessfully pointed it out to the examiner. Where is it in the drawings, it should be simple to point it out?

This application in **NOT** in condition for allowance and notice to that effect is **DENIED**.

Conclusion

14. Applicants' amendment necessitated the new grounds of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Replacement Notice: Copies of Patent Application Records will be Provided in both Electronic and Paper Form

The Official Gazette notice, published on August 24, 2004 entitled "*All Electronic Copies of Patent Application Records Will Now Be Provided as Certified Copies in Electronic Form*" (1285 Off. Gaz. Pat. Off, August 24, 2004) is hereby rescinded. The USPTO is reinstating, until further notice, the procedures in effect prior to July 30, 2004 for providing certified copies of patent application records with paper certification statements. The USPTO will also offer electronic certified copies of patent application records at the requester's option.

Certified Copies with Paper Certification

Unless otherwise requested, certified copies of patent application records provided pursuant to 37 CFR 1.19 (b) will be produced with a paper certification statement, continuing the practice in effect prior to July 30, 2004. The certification statement will include an embossed seal and original signature.

Certified Copies with Electronic Certification

Customers ordering certified copies of patent applications as filed or patent-related file wrapper and contents of published applications from the USPTO website will have the option to choose electronic copies with electronic certification. These files include an imaged certification statement as part of a PDF file containing the document TIFF images. These electronic files are digitally signed by the USPTO for authenticity and integrity, and cannot be undetectably modified. Customers may choose to download these electronic files from the USPTO website or receive them on compact disc.

Paris Convention for the Protection of Industrial Property and Priority

Irrespective of whether the USPTO provides a paper certified copy or an electronic certified copy, Article 4(d)(3) of the Paris Convention prohibits any country that is a member of the convention from requiring further authentication of the certified copy for purposes of claiming priority under the Paris Convention. (The text of the Paris Convention and a list of its members are available at www.wipo.int/treaties/en/ip/paris/index.html.)

The USPTO is working with other intellectual property offices to encourage the acceptance of priority documents in electronic form with electronic certification. A list of offices and international intellectual property organizations that have agreed to accept electronic certified copies will be posted on the USPTO website soon, and updated regularly.

Questions should be directed to the Office of Public Records by email to opr@uspto.gov or by telephone at (703) 308-9743.

17. If applicants wish to request for an interview, an *"Applicant Initiated Interview Request"* form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. A copy of the completed *"Applicant Initiated Interview Request"* form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative.

18. If applicants request an interview after this **final rejection**, prior to the interview, the intended purpose and content of the interview should be presented briefly, in writing. Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to **restate arguments** of record or to **discuss new limitations** which would require more than nominal reconsideration or new search will be denied.

19. Consolidated Appropriations Act, 2005 enacted on December 8, 2004

H.R. 4818, the Consolidated Appropriations Act, 2005 (Consolidated Appropriations Act) was signed by President George W. Bush and enacted into law on December 8, 2004. The Consolidated Appropriations Act revises certain patent application and maintenance fees; provides separate fees for a basic filing fee, a search fee, and an examination fee; and requires an additional fee for any patent application whose specification and drawings exceed 100 sheets of paper (application size fee). The new patent fees are now effective and will remain in effect during the remainder of fiscal year 2005 and during fiscal year 2006. The patent maintenance fee changes apply to any maintenance fee payment made on or after December 8, 2004, regardless of the filing or issue date of the patent for which the fee is submitted. The revised maintenance fees took effect on December 8, 2004. Thus, any maintenance fee paid at any time on (or after) December 8, 2004 is subject to the revised maintenance fee amounts set forth in the Consolidated Appropriations Act.

Note: If you are paying via the USPTO's Internet Web site, there will likely be a delay in updating the maintenance-fee information on the USPTO's Office of Finance On-Line Shopping Web page. Therefore, if paying on-line, please refer to the updated fee schedule to ensure that you include the appropriate updated fee amount. Maintenance fees must be timely paid in the appropriate amount to avoid expiration of a patent.

The new basic filing fee (or national fee), search fee, examination fee, and application size fee apply to national patent applications (other than provisional applications) filed on or after December 8, 2004, and to international patent applications in which the basic national fee is paid on or after December 8, 2004. The new provisional application filing fee applies to any provisional application filing fee paid on or after December 8, 2004. The filing fee (or national fee), search fee, and examination fee are due on filing. If the filing fee (or national fee) is paid on filing, but the search fee and/or examination fee is missing, the USPTO will issue a notice requiring that any missing search fee and examination fee (but no surcharge until further notice) be paid within a specified period of time in order to avoid abandonment. Thus, if at least the full basic filing fee under the Consolidated Appropriations Act is paid on or after December 8, 2004, the USPTO will issue a notice requiring any balance of the search fee and the examination fee (but no surcharge). The remaining patent application fee changes, including the excess claims fees, extension of time fees, and appeal fees, apply to any fee payment made on or after December 8, 2004, regardless of the filing date of the application for which the fee is submitted.

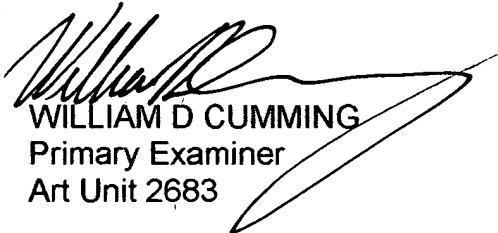
USPTO customers should monitor the USPTO's Internet Web site frequently for current patent fee information.

Payments from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM D CUMMING whose telephone number is 571-272-7861. The examiner can normally be reached on Tuesday & Wednesday, 10:30am to 8:30pm,.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


WILLIAM D CUMMING
Primary Examiner
Art Unit 2683

Wdc



UNITED STATES
PATENT AND
TRADEMARK OFFICE

William Cumming
Primary Patent Examiner
William.Cumming@uspto.gov